

REMARKS

Claims 1 - 40 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC 103(a) Over Lee at al. 5,792,412 in view of Shaw et al. 6,420,003

Claims 1 - 40 have been rejected under 35 USC 103(a) as being unpatentable over Lee at al. 5,792,412 in view of Shaw et al. 6,420,003.

Applicants respectfully traverse the rejection on the ground that the Examiner has not met the requirements of MPEP § 2143 for establishing of a *prima facie* case of obviousness with regard to the rejected claims. As shown below, the Applicants respectfully submit that the Examiner has failed to show at least two of the three requirements of a *prima facie* case of obviousness.

According to MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

With respect to the first requirement for some suggestion or motivation to modify the reference or to combine reference teachings, U.S. Court Of Appeals For The Federal Circuit reinforced the test for obviousness, requiring a "rigorous application of the requirement for a showing of the teachings or motivation to combine prior art *In re Anita Dembiczak and Benson Zinbarg*, 175 F.3d 994 (1999); U.S. App. LEXIS 8109; 50 U.S.P.Q.2D (BNA) 1614. Moreover, "the showing must be clear and particular." *Id.*, citing *C.R. Bard*, 157 F3d 1340 at 1352, 48 U.S.P.Q.2D (BNA), at 1232."

However, the Examiner did not show where in the Shaw et al. reference, which discloses a thermoplastic container or packaging material having oxygen barrier properties, is there suggestion or motivation to modify the Lee at al. reference, which discloses apertured films having durable wettability suitable for transporting liquid in absorbent articles, or to combine the teachings of the Lee at al. reference with the Shaw et al. reference in order to arrive at the claimed invention. Moreover, as it will be argued by the Applicants below, the Shaw et al. reference is nonanalogous art on both counts: (a) it is not in the field of Applicants' endeavor and (b) it is not

pertinent to the particular problem with which the inventors were concerned. Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to the first criteria a *prima facie* case of obviousness, the rejection under 35 USC 103 (a) should be withdrawn.

Further, the Examiner did not show where in the references there is reasonable expectation of success of arriving at the claimed invention. In fact, the combination of teachings of the cited references will not result in the claimed invention because, according to the Applicants, the combination of teachings will result not in the increase but in the reduction of durability of wettable liquid pervious webs of the claimed invention due to the presence of "at least one migratable surfactant" in the polymeric film of the Lee et al. teaching that will inhibit the attachment of the acrilate layer (polymerized by irradiation of the Shaw et al. reference to the polymeric film of the Lee et al. reference). Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to the second criteria a *prima facie* case of obviousness, therefore, the rejection 103 (a) should be withdrawn.

Shaw et al. is Nonanalogous Art

According to MPEP,

"A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2145(i), quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

It is submitted that it is neither in the field of Applicants' endeavor, nor reasonably pertinent to the particular problem with which the present inventor was concerned.

Shaw et al. is not in the field of Applicants' endeavor

The claimed invention is concerned with durably wettable liquid pervious webs suitable as topsheet for absorbent articles, such as diapers and feminine hygiene products. Shaw et al. , on the other hand, is concerned with packaging materials having low oxygen permeability by having an oxygen barrier layer. Clearly, Shaw et al. is not in the field of Applicants' endeavor.

In *In re Carl D. Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), the Federal Circuit held the references to be nonanalogous to the claimed invention even though both the invention and the references were used in the petroleum industry and both involved handling petroleum products in volumetric enclosures. The claimed invention claimed a method for storing refined petroleum products in a man-made storage tank, while the reference concerned a method for extracting a crude oil from porous natural underground formations. Nevertheless, the Federal Circuit found that the reference could not “be considered to be within [the applicant’s] field of endeavor merely because both relate to the petroleum industry.”

In the present instance, Shaw et al. and the claimed invention do not even relate to the same industry. As shown above, Shaw et al. relates to packaging materials having oxygen barrier properties, while the claimed invention relates to durably wettable liquid pervious webs suitable as topsheet for absorbent articles, such as diapers and feminine hygiene products. Consequently, Shaw et al. is not in the field of Applicants’ endeavor.

Shaw et al. is not reasonably pertinent to the particular problem with which the inventors were concerned

According to MPEP,

“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor’s attention in considering his problem.” MPEP 2141.01(a), citing *In re Carl D. Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) and *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767, (Fed. Cir. 1993).

In *In re Carl D. Clay*, the Federal Circuit stated that

“the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of this reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.”

The present invention solves the problem of liquid-perviousness and wetness durrability, but Shaw et al. solves the problem of oxygen barrier. Shaw et al. teaches a metal oxide layer for the oxygen barrier and layers of an crylate enclosing the metal oxidate layer cured by irradiation, whithout suggesting to use the accrilate layer cured by radiation to solve the above problem of

the claimed invention. Thus, it is clear that the present invention and Shaw et al. have absolutely different purposes and do not relate to the same problem. Consequently, Shaw et al. is not reasonably pertinent to the particular problem with which the instant inventor was concerned.

To the extent the respective fields of endeavor and reasonable pertinence are concerned, the differences between the claimed invention and Shaw et al. are much greater than those between the invention and the prior references in *In re Carl D. Clay*, in which the Federal Circuit invalidated the references holding them to be nonanalogous to the invention.

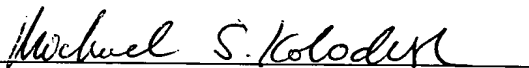
Summarizing, Shaw et al. neither is in the field of Applicants' endeavor nor is reasonably pertinent to the particular problem with which the Applicants were concerned. Therefore, Shaw et al. is not an analogous art. Accordingly, the rejection based on Shaw et al. should be withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of the pending Claims 1-40.

Respectfully submitted,  
PAUL FRANCE, et al.

  
By Michael S. Kolodesh  
Agent for Applicants  
Registration No. 44, 846  
(513) 634-0541

December 11, 2003  
Customer No. 27752